APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,379	02/28/2002	Akemi Hirotsune	H&A-108	1244

7590   02/25/2008
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EXAMINER
AUGUSTIN, EVENS J

ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
02/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/084,379	HIROTSUNE ET AL.
	Examiner	Art Unit
	EVENS J. AUGUSTIN	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☐ Claim(s) _____ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. This is in response to an amendment filed on 12/26/2007. Claim 43 has been added. Claims 1-43 are pending.

Response to Arguments

2. The United States Patent and Trademark Office has fully considered the applicant's arguments filed on 12/26/2007, but has not found those arguments to be persuasive.

Argument 1: Ueki does not disclose or suggest a recording-limited area in which recording of information in the recording-limited area is performed after the canceling of the recording limit, as claimed in the independent claims.

Response 1: The invention is regarding an optical disk such as DVD-R or CD-RW (heron referred to as disk). The scope of the invention is geared towards a computer recording data on a disk, the computer reads the disk for previously recorded data, which is then displayed to the user (in this case, the pre-recorded data happens to be advertisement). Data is recorded on disks by reading or allocating sections of the disk that are empty. Each section is provided with an internal address that is being read during recording (the claim uses the term "rendering allocation information that is being read out during recording"). Data is recorded on a disk by etching bumps or pits on the disk which are then converted into zeros or ones. In the case where a disk contains data, the allocation information will not be read, signaling an error on the disk. The error data can be displayed to the user in the form of copyright information, advertisement or whatever needs to be displayed to the user (see: http://computer.howstuffworks.com/cd-burner.htm and Figures 12-16, column 11, lines 30-48 of the prior art).

The prior art contains a recordable disk that displays pre-recorded copyright information to the user, before data is recorded on the disk. With regard to the limitation of "recording medium…has a recording limit and is recognized as an area in which recording of information cannot be performed", as described in claim 1, the allocation information of the pre-recorded area would not be read, and therefore causing information to be displayed to the user. The area which contains the displayed (pre-recorded) information would not necessarily be recorded thereon (inherency).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-6, 8-10, 12-33 and 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueki (U.S 6, 678236), in view of Maeda et al. (US 6654547).

2. As per claims 1-6, 8-10, 12-33 and 35-42, Ueki discloses a method and an apparatus for recording information on a recording medium. In addition, this invention relates to a method and an apparatus for reproducing information from a recording medium. The invention comprises of:

A. The **lead in area** of the disk **is being made a recording-limited area** by **error correction process on a signal read out from a recording disc, for example, a DVD-Video or a DVD-RW.** In this case, the **signal or data being read** is copy protection data (column 10, lines 33-36, lines 44-54). However, artisans in the art would understand that the **data could any data, including advertising data (Per Merriam-Webster's dictionary, data = 1**: information output by a sensing device or organ that includes both useful and irrelevant or redundant information and must be processed to be meaningful **2**: information in numerical form that can be digitally transmitted or processed) -- **("providing a recording limited area on a recording medium that has a recording limit and is recognized as an area in which recording of information cannot be performed")**

B. Figure 15 shows the sequence of events in the lead area when recording is initiated. First, the data is recorded (pre-recorded), and continues until pit area where the prerecorded data is located. At that point, recording is suspended and the system changes operation from recording to playback. **At the end of the playback operation recording is resumed (equivalent to canceling the recording-limited area)** (column 26, lines 48-67). Data is recorded in the lead-in area (column 11, lines 1-15) --**(" canceling the recording limit for the recording-limited area")** --.

C. Content to be recorded in the lead in area contains data sectors and those sectors are composed of **ID information (equivalent to address information),** an ID-information error correction code (IED) 22, reserved data, a data region 24, and an error detection code (EDC) (column 11, lines 31-37). **Address information or allocation data is**

recorded in the lead in area (column 17, lines 15-37) --(**" recording new-information in said recording-limited area after said canceling of the recording limit")**; (**"recording limit is provided by rendering a read-out of allocation information for said recording-limited area impossible, and the step of canceling the recording limit comprises a step of recording allocation information for said recording-limited area in said recording medium"); ("recording limit limits recording by rendering an ID error detection code of address information for said recording-limited area inconsistent with an ID corresponding to said ID error detection code, and the canceling of the recording limit is performed by rendering said ID error detection code thus made inconsistent, to be consistent with said ID")**--

D. The pre-recorded data, in this case, copyright information of disk, **is represented by pits** (column 9, lines 48-49). At an initial stage of a recording mode of operation of the apparatus, the **address information** is reproduced from the address pre-pits in the DVD-RW. During a later stage of the recording mode of operation, **recording positions on the DVD-RW are decided in response to the address information** (equivalent to allocation information)**, and lead-in information and contents information are recorded on the decided recording positions of the DVD-RW** (column 18, lines 30-36). The lead-in area has recording areas, **except where the copyright information is location** (column 17, lines 1-21). **Inherently, since the copyright information area cannot be erased or overwritten (column 14, lines 17-20),** the reading of its address information **is impossible**. Since no recording can be done in prerecorded area, the address information is **inherently erased (can't be read)** --*Claims 2-3, 9-10, 13-16*

E. Figure 15 shows the sequence of events in the lead area when recording is initiated. First,
the data is recorded, and continues until pit area where the prerecorded data is located.
At that point, recording is suspended and the system changes operation from recording to
playback. **At the end of the playback (display/readout) operation recording is
resumed (equivalent to canceling the recording-limited area)** (column 26, lines 48-
67). Since no recording can be done in prerecorded area, the address information is
inherently **erased (can't be read)– ("recording limit is provided by rendering a read-
out of allocation information for said recording-limited area impossible, and the
step of canceling the recording limit comprises canceling the recording limit using
predetermined software")** --

F. First, the data is recorded (pre-recorded), and continues until pit area where the
prerecorded data is located. At that point, recording is suspended and the system changes
operation from recording to playback. **At the end of the playback operation recording
is resumed (equivalent to canceling the recording-limited area)** (column 26, lines 48-
67). Data is recorded in the lead-in area (column 11, lines 1-15). The playback signal
(pre-recorded information) can be displayed/readout via a **monitor device (a display)**
(column 21, lines 9-10) – the aspect of issuing instructions to do the above is inherent.
The above steps have to necessarily be initiated by computer instructions - **("providing
pre-recorded information"); ("issuing an instruction to record information to said
recording medium prior to the canceling of said recording limit; and issuing an
instruction for reading the pre-recorded displaying predetermined information in
response to the recording instruction being issued")** --

G. The lead-in area of the disc contained **predetermined information** (column 7, lines 26-28). That **predetermined information** can be information related to the manufacture of the disc, information of a contents start position, and copyright-protection-related information (column 17, lines 5-7). **Since is that information is predetermined, one skilled in the art would be able to put <u>any type of previously recorded information on the disk, including advertisement.</u>** –

H. As previously shown, the pre-recorded is displayed through **error** or **defective** read out (column 10, lines 33-36, lines 44-54). The system also shows that it can correct the errors, where the data amount (the number of bits) of the recorded copyright-protection-related information is within the range of the ability of an ECC (**error correction code**) block, containing the pre-pit area, to **correct errors** (equivalent to no longer defective) (column 10, lines 33-44). -

I. Figure 15 shows the sequence of events in the lead area when recording is initiated. First, the data is recorded, and continues until pit area where the prerecorded data is located. At that point, recording is suspended and the system changes operation from recording to playback. **At the end of the playback operation *(which is the specified event)*, recording is resumed (equivalent to canceling the recording-limited area)** (column 26, lines 48-67) –

J. The playback signal can be displayed via a **monitor device (a display)** (column 21, lines 9-10) -

3. Ueki did not explicitly describe a method/system in which the prerecorded is an advertisement. However, Maeda et al. describes an invention that relates to DVD (Digital

Versatile Disc) rental systems and methods, and more specifically, to a DVD rental system and method for recording video and sound on a DVD, and lending the DVD to a user. According to Maeda et al., the user presses a PLAY button to make an instruction for starting playback. In response, the playback/recording controller 36 instructs the DVD read part 32, the MPEG decoder 34, and the video display part 35 to execute a Commercial Message (CM) or advertisement playback process as follows. That is, the CM recorded in step S302 is read from the RAM area 1b of the DVD 1, and the decoded CM is converted into video signals for output to the television receiver (step S306). This CM playback process ends after a predetermined number of CMs, for example, six CMs (their total time is 1 and a half minutes) are played-back (figure 7, col. 12, ll. 13-23).

4. Therefore, it would have been obvious for one skilled in to provide CDs or DVDs, which has prerecorded advertisement on them. The reason for doing so would provide a DVD rental system and method that can have a user (renter) view video and sound recorded on a DVD together with CMs with high advertising effectiveness and, as a result, can sufficiently reduce a rental fee to be charged to the user (col. 2, ll.10-14).

5. Claims 11 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueki (U.S 6, 678236), in view of Maeda et al. (US 6654547) and in further of Nishio (US 5887192).

6. As per claims 11 and 34, Ueki and Maeda et al.'s inventions have previously been disclosed.

7. Ueki and Maeda et al. did not explicitly describe a method/system in which data on the disk is encrypted.

8.   However, Nishio describes an invention that teaches movie data on a CD, along with

advertisement data (col. 5, ll. 40-43). According to Nishio, unit data may be each previously

encrypted or compressed. If the unit data is compressed beforehand, there may be provided an

expanding means for restoring the unit data by expanding the compressed unit data. If the unit

data is encrypted beforehand, there may be a decrypting means for decrypting the encrypted

software (col. 3, ll. 20-24).

9.   Therefore, it would have been obvious for one skilled in to provide system in which data on a

disk encrypted. The reason for doing so would be because encryption prevents unauthorized

access to data, especially during transmission.

Conclusion

4.   **THIS ACTION IS MADE FINAL.** Any new ground(s) of rejection is due to the

applicant's amendment. Applicant is reminded of the extension of time policy as set forth in

37 CFR 1.136(a).

5.   A shortened statutory period for reply to this final action is set to expire THREE MONTHS

from the mailing date of this action. In the event a first reply is filed within TWO MONTHS

of the mailing date of this final action and the advisory action is not mailed until after the end

of the THREE-MONTH shortened statutory period, then the shortened statutory period will

expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

6.   In determining patentability of an invention over the prior art, the USPTO has considered all

claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally,

all words in the claims have been considered in judging the patentability of the claims against

the prior art.

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to EVENS J. AUGUSTIN whose telephone number is 571-272-

6860. The examiner can normally be reached on 10am - 6pm M-F.

8.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Fischer can be reached on (571)272-6779.

Evens J. Augustin
February 28, 2008
Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621